

REMARKS

Applicants cancelled claim 10, and amended claims 4 and 21. Claims 4-9, 11-13 and 21-25 are pending.

The Examiner rejected claims 4-8, 10-13, 24 and 25 under 35 U.S.C. §103(a) as being unpatentable over Chevallier in view of Mangin.¹ These claims require a plurality of substantially spherical porous particles in a carrier fluid. It would not have been obvious to one skilled in the art to combine Chevallier and Mangin to provide such subject matter. Chevallier discloses precipitated particles designed for use as a reinforcing filler in elastomers (*see, e.g.,* Chevallier, Abstract), whereas Mangin discloses particles designed for use in embolization. *See, e.g.,* Mangin, Abstract. For example, as explained by the United States Court of Appeals for the Federal Circuit “[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992); *see also* MPEP §2141.01(a). Chevallier and Mangin are in very different fields of endeavor, and Chevallier is not reasonably pertinent to the problem with which Mangin was concerned. Thus, Chevallier is non-analogous art to Mangin. Accordingly, the Examiner's proposed combination of Chevallier and Mangin is improper. To the extent the Examiner has a contrary view, the burden is on the Examiner to explain with evidence, and not conclusory statements, why it would have been obvious to one skilled in the art to combine Chevallier and Mangin in the manner indicated by the Examiner. *See, e.g.,* MPEP §2144.03. For example, one basic consideration for using a particle in the manner taught by Mangin is whether the particle has appropriate characteristics to be used in the body. The Examiner provides no evidence in this regard, and instead appears to take a “all silica particles are alike” mentality, at least inasmuch as the Examiner fails to acknowledge that the differences between Chevallier's particles and Mangin's particles could result in differences with respect to using the particles as taught by Mangin. *See, e.g.,* Office Action, p. 4.

¹ Applicants cancelled claim 10, so the rejection of this claim should be withdrawn.

Further, these claims require the particles to have a pore volume distribution such that about 70% or more of the pore volume of the particles is made up of pores having pore diameters which have a tolerance of about 10 nm or less on the mean pore diameter. Neither Chevallier nor Mangin explicitly disclose that their particles have such a pore volume distribution. Under MPEP §2112, the Examiner has the burden of showing that Chevallier inherently discloses particles with the particle pore volume and tolerance required by these claims. The Examiner has not satisfied this burden. The mere fact that Chevallier discloses particles with certain pore diameters and certain pore volumes does not mean that Chevallier's particles necessarily have Applicants' claimed pore volume and tolerance. The Examiner seems to indicate that all particles having a certain pore volume and pore diameter would also have Applicants' claimed pore volume and tolerance. The Examiner cites certain cases in an apparent attempt to shift the burden to Applicants to demonstrate that Chevallier's particles do not inherently possess Applicants' claimed pore volume and tolerance. But, the Examiner's reliance on *Spada* and *Fitzgerald* is improper because those cases are properly applied under very different facts, where, for example, the Examiner has established that the claimed product and the prior art product are substantially the same. *See, e.g.*, MPEP §§2112 and 2112.01. Here, the Examiner has not established that Chevallier's particles are substantially the same as Applicant's claimed particles. The Examiner's reliance on *Swinehart* is also improper as this case seems inapposite to the facts presented here.

Limitations in various claims provide additional bases for patentability. As an example, claims 11 and 25 recite that the particles exhibit a loss of attrition resistance of about 0.1% by weight or less. Neither Chevallier nor Mangin explicitly disclose that their particles have such a loss of attrition resistance. Here again, the Examiner's approach to trying to establish inherent disclosure in Chevallier is improper, for reasons similar to those noted in the preceding paragraph.

In view of the foregoing, Applicants request reconsideration and withdrawal of the rejection of claims 4-8, 11-13, 24 and 25.

The Examiner rejected claims 4, 9 and 21-23 under 35 U.S.C. §103(a) as being unpatentable over Kirkland. Applicants amended these claims to obviate the rejections, so the rejections should be withdrawn.

Applicant : Kalpana Kamath et al.
Serial No. : 10/814,079
Filed : March 30, 2004
Page : 8 of 8

Attorney's Docket No.: 01194-0447001 / 02-160US

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: June 12, 2009

/Nicholas M. Boivin/
Nicholas M. Boivin
Reg. No. 45,650

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (877) 769-7945

22194261.doc